

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Application Number | : 10/618,249 | Confirmation No.: | 4607 |
| Applicant | : Brake et. al. | | |
| Filed | : July 11, 2003 | | |
| Title | : Customer Activated Multi-Value (CAM) Card | | |
| TC/Art Unit | : 3692 | | |
| Examiner: | : Elda G. MILEF | | |
| Docket No. | : 47004.000251 | | |
| Customer No. | : 21967 | | |

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action dated May 12, 2008 ("Office Action"), Applicants submit this Pre-Appeal Brief Request for Review. This Request is being filed with a Notice of Appeal. No amendments are being filed with this Request. Reconsideration and allowance are respectfully requested.

In paragraph 6 of the Office Action, the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,014,645 to Cunningham (hereinafter "Cunningham") in view of "Visa, MBNA and De La Rue Launch Multi-Function Smart Card Program," PR Newswire (July 6, 1998) (hereinafter "De La Rue") and U.S. Patent No. 6,000,608 to Dorf (hereinafter "Dorf"). This rejection is respectfully traversed.

Applicants' claim 1 is presented below, with emphasis added:

1. A method using a computer system for *customer activation of a multi-value card having a primary feature and one or more optional secondary features*, wherein the system automatically processes a customer's activation of the multi-value card, said system including a data entry processing center, a workstation, a graphical user interface, and a data storing means comprising the steps of:

- a) receiving said customer's request into said system;
- b) providing at least one or more safety features *to determine whether said customer is the person whose name is printed on said multi-value card*; and
- c) *offering said customer the options of activating the multi-value card by:*
 - 1) confirming the customer's desire to activate the primary multi-value card use;

- 2) *determining the customer's election to add a secondary credit card feature;*
- 3) *identifying the customer's request to activate any additional use features; and*
 - d) *storing information related to each feature on the multi-value card in a machine-readable format,*
wherein an application for the multi-value card is processed as part of an integrated application process whereby the primary multi-value card use, the secondary credit card feature and any additional use features are established in response to a single customer application, and wherein the primary multi-value card use, the secondary credit card feature and any additional use features are associated with the multi-value card prior to issuance of the multi-value card with each feature capable of being activated after issuance.

Cunningham discloses a real-time financial card application system. The Cunningham system presents financial card (e.g., credit card, debit card) offers to potential customers. Financial card applicant selection criteria and financial card term data are provided by participating financial institutions. An applicant interested in applying for a new financial card accesses the system via the Internet/World Wide Web. The applicant provides personal and financial data that are then analyzed in conjunction with data from outside sources (such as credit bureaus) to determine a financial risk rating for the applicant. The rating is used to locate financial card offers appropriate for the applicant. The applicant then peruses the offers and chooses one that meets his or her personal selection criteria. The applicant's data is then forwarded for processing to the participating financial institution that made the selected offer. *See Cunningham Abstract.*

Essentially, the Cunningham system is a system that matches up offers for conventional credit cards with eligible applicants.

Cunningham does not disclose or suggest at least the following elements from claim 1:

- “A method of using a computer system for *customer activation*.” Cunningham is not concerned with customer activation. The Cunningham system does not do anything past the stage of forwarding the applicant's data to the financial institution offering the card, which occurs even before the card is *issued* by the financial institution.
- “A method of using a computer system for customer activation of a *multi-value card having a primary feature and one or more optional secondary features*.” The Cunningham system relates only to conventional financial cards (e.g., credit and debit cards) offered by

financial institutions. These conventional financial cards are not multi-value cards and they don't have primary features and optional secondary features.

- “(b) providing one or more safety features to determine whether said customer is the person whose name is printed on said multi-value card.” This step is not disclosed or suggested in col. 3, lines 23-26 of Cunningham (as alleged in the Office Action) or anywhere else in Cunningham.

- “(c) offering said customer the option of activating the multi-value card.” Cunningham is not concerned with activation of the card.

As acknowledged in the Office Action (pp. 6-7), Cunningham also does not disclose or suggest:

- “(2) determining the customer's election to add a secondary credit card feature”;
- “(3) identifying the customer's request to activate any additional use features”;
- “(d) storing information related to each feature on the multi-value card in a machine-readable format,

wherein an application for the multi-value card is processed as part of an integrated application process whereby the primary multi-value card use, the secondary credit card feature and any additional use features are established in response to a single customer application, and wherein the primary multi-value card use, the secondary credit card feature and any additional use features are associated with the multi-value card prior to issuance of the multi-value card with each feature capable of being activated after issuance.” See Office Action at pp. 6-7.

Applicants respectfully point out, initially, that Cunningham is missing a large number of elements from claim 1, as identified above.

The Office Action cites De La Rue to remedy all of these deficiencies of Cunningham. However, De La Rue cannot cure Cunningham's deficiencies for the following reasons.

De La Rue relates to a multi-function smart card that includes a credit card feature, a stored value feature, and a loyalty function. The loyalty function allows up to nine different rewards programs. See De La Rue p. 1.

The De La Rue smart card, however, does not give the customer any freedom in choosing the features of the card. The features of the De La Rue smart card are fixed before the card is sent to the cardholder. For example, on page 1, De La Rue states that “[t]he rewards and award

thresholds of the loyalty applications can be easily changed *to target different cardholders.*” In other words, the features of the De La Rue card are pre-selected *by the issuer* to target different cardholders. De La Rue does not disclose or suggest:

- “(c) offering said customer the option of activating the multi-value card by:
 - 1) confirming the customer’s desire to activate the primary multi-value card use;
 - 2) determining the customer’s election to add a secondary credit card feature;
 - 3) identifying the customer’s request to activate any additional use features.”

Rather, these features are fixed by the card issuer before the card is sent to the cardholder. The cardholder doesn’t have any ability to select different features of the De La Rue card.

De La Rue also does not disclose or suggest:

- “A method using a computer system for *customer activation.*” The De La Rue article does not discuss activation.
- “a multi-value card having a primary feature and one or more *optional secondary features.*” The features on the De La Rue card are not optional. Each card has a credit card feature, a stored value feature, and a loyalty application.
- “(b) providing at least one or more safety features to determine whether said customer is the person whose name is printed on said multi-value card.” This feature is not disclosed or suggested in De La Rue.

The Office Action also acknowledges that “Cunningham and De La Rue do not specifically disclose “that each feature capable of being activated after issuance.” See Office Action p. 8.

Because these numerous claimed features identified above are absent from both Cunningham and De La Rue, the combination of Cunningham and De La Rue cannot possibly produce Applicants’ claim 1 combination.

The Office Action cites col. 10, lines 48-64 of Dorf for an alleged teaching of activating various functions. See Office Action p. 9. However, Dorf does not teach activating, as alleged in the Office Action. The cited passage in Dorf (col. 10, lines 48-64) merely describes a procedure for identifying which function is currently being used by the cardholder for a particular transaction. This is not the same as activation, as understood by one skilled in the art. The Examiner’s interpretation would mean that, for example, a credit card is activated every time

it is used, which is not a reasonable interpretation of the term “activation” to one skilled in the art.

Furthermore, and more significantly, Dorf doesn’t remedy the other numerous deficiencies noted above of the Cunningham/De La Rue combination. Therefore, the combination of Dorf, Cunningham, and De La Rue cannot possibly produce Applicants’ claim 1 combination.

For the foregoing reasons, Applicants respectfully submit that claim 1 is allowable over the combination of Cunningham, De La Rue, and Dorf.

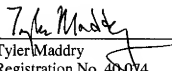
Independent claim 35 contains similar limitations and is believed to be allowable for substantially the same reasons. Claims 36-59 and 68-69 depend from and include the recitations of claim 35 and are believed to be allowable for at least the same reasons that claim 35 is allowable.

Applicants respectfully submit that the application is in condition for allowance and notice to the effect is earnestly solicited. If there are any questions regarding this Request or the application in general, the Examiner is encouraged to contact the undersigned to expedite prosecution.

The Commissioner is authorized to charge any fees due in connection with the filing of this paper to the undersigned’s Deposit Account No. 50-0206.

Respectfully submitted,
HUNTON & WILLIAMS LLP

Date: Aug. 12, 2008


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